



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,865	02/09/2005	Robin Matthews	04356-PCT-PA	5818

72468 7590 12/24/2008
HODES, PESSIN & KATZ, P.A
901 DULANEY VALLY ROAD, SUITE 400
BALTIMORE, MD 21204

EXAMINER

YIP, JACK

ART UNIT	PAPER NUMBER
----------	--------------

3715

MAIL DATE	DELIVERY MODE
-----------	---------------

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,865	Applicant(s) MATTHEWS, ROBIN	
	Examiner JACK YIP	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-10,19,20,38,39,41,42 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2,6-8,9-10,19-20,38-39,41-42,46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/17/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3715

DETAILED ACTION

Action on the Merits of the Elected Invention

1. In response to the Election to restriction requirement filed 9/18/2008; claims 1-2,6-7,9-10,19-20,38-39,41-42,46-48 are pending; claims 3-5,8,11-18,21-28,31,34,37,40,43-45,49-51 are cancelled; claims 29-30,32-33,35-36 are not elected.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 - 2, 6 - 7, 38 - 39, 41 - 42, 48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claims 1 - 2, 6 - 7, 38 - 39, 41 - 42, 48: Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For the instant application, applicant discloses methods (processes) for simulating an athletic event; however there is no apparatus in the claim disclosure for such the method to be performed on.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 3715

5. Claims 1-2,6-7,9-10,19-20, 41-42,46-48 are rejected under 35 U.S.C. 102(a) as being anticipated by Madden NFL 2002 for PlayStation 2 (release 8/19/2001) evident by www.gamespot.com (denoted herein after as Madden).

Madden discloses

Re claim 1:

A method for simulating an athletic event, comprising (Madden, pg 1 - 3):

entering players for positions in a squad on an offensive (Madden, pg 16), defensive or special team (Madden, pg 16 - 17), wherein each player has vital statistics, general attributes (Madden, pg 9, "The height and weight stats are customizable..."), offensive/defensive attributes (Madden, pg 16 - 17) and specialized attributes which predict athletic performance (Madden, pg 9, "With the game's extensive general manager options, you can do everything from creating a player to creating an entire team...If you enjoy customizing your own team and players...");

placing each player in a formation (Madden, from pg 16, "2. Player Positions");

establishing a play based on the formation in which the moving pattern and activity of each player is defined (Madden, from pg 16, "2. Player Positions");

simulating the play by having each player executing the moving pattern and activity as modified by the vital statistics, general attributes, offensive/defensive attributes and specialized attributes associated with each player, wherein the outcome of the play is based upon the moving patterns and activities as modified by the attributes associated with each player. (Madden discloses a video game that simulating a real football game where a user can assign each player of position (Madden, from pg 16, "2. Player Positions"), wherein each player has his/her own attributes/abilities (Madden, from pg 106, "Breakdown").)

Re claim 48:

Art Unit: 3715

The method of claim 1, wherein the attributes associated with each player comprise at least one of the players vital statistics, general attributes (Madden, pg 9), offensive/defensive attributes and specialized attributes (Madden, from pg 106, "Breakdown").

Re claim 2:

The method for simulating an athletic event recited in claim 48, wherein the vital statistics comprise the player's height and weight (Madden, pg 9), wherein the general attributes comprise acceleration (Madden, pg 16; pg 53 - 61), agility (Madden, pg 16; pg 53 - 61), awareness (Madden, pg 87 - 88; pg 106 - 107), elusiveness (Madden, pg 54 - 61; pg 97), jumping (Madden, pg 53 - 61), speed (Madden, pg 53 - 61), stamina (Madden, pg 91), and strength (Madden, pg 53 - 61), wherein the offensive/defensive attributes comprise breaking tackles (Madden, pg 16; pg 55 - 61), catching (Madden, pg 55 - 61), pass blocking (Madden, pg 90, pg 106), run blocking (Madden, pg 90, pg 106), throwing accuracy (Madden, pg 16; pg 58; pg 90), and throwing power (Madden, pg 16; pg 58; pg 90), wherein the specialized attributes comprise injury recovery (Madden, pg 33; "Once the season is over, the player will come off the IR if the injury was not career-ending..."), toughness (Madden, pg 257), instinct and experience (Madden, pg 257).

Re claim 6:

The method for simulating an athletic event recited in claim 1, further comprising: entering each play in a playbook categorized according to the type of play (Madden, from pg 209, "PLAYBOOKS").

Re claim 7:

The method for simulating an athletic event recited in claim 1, further comprising: viewing the play as either a two-dimensional overhead view, a two - dimensional side view, or a three-dimensional animated player view (Madden, pg 2) and further comprising exporting the play established in the form of a movie (Madden, pg 8 - 9).

Re claim 9:

Art Unit: 3715

A system for simulating an athletic event (Madden, pg 1 - 3), comprising:

a player module to enter players for positions in a squad on an offensive, defensive or special team, wherein each player has attributes which predict athletic performance (Madden, from pg 16 - 17);

a play module to establish a play based on a formation in which the moving pattern and activity of each player is defined; and (Madden, from pg 16 - 17)

a run designed play module to simulate the play by having each player executing the moving pattern and activity as modified by the vital statistics, general attributes (Madden, pg 9, "The height and weight stats are customizable..."), offensive/defensive attributes (Madden, pg 16 - 17) and specialized attributes associated with each player (Madden, pg 9, "With the game's extensive general manager options, you can do everything from creating a player to creating an entire team...If you enjoy customizing your own team and players..."), wherein the outcome of the play is based upon the moving patterns and activities as modified by the attributes associated with each player (Madden, from pg 16).

Re claim 10:

The system for simulating an athletic event as recited in claim 9, further comprising:

a squad creation module to create a squad of players based upon the players entered using the player module (Madden, from pg 16, from pg 209), wherein each squad of players is associated with some specific game function, further comprising: a formation module to establish the formation using the squad of players, further comprising: a playbook module to enter each play in a playbook categorized according to the type of play (Madden, from pg 209, "PLAYBOOKS"), further comprising: a player specific camera viewing module to view the play as either a two- dimensional overhead view, a two-dimensional side view, or a three-dimensional animated player view (Madden, pg 2), further comprising: an exporting play module to export the play established in the form of a movie (Madden, pg 8 - 9).

Re claim 19:

A computer program embedded in a computer readable medium for simulating an athletic event, comprising (Madden, pg 1 - 3):

Art Unit: 3715

a player code segment to enter players for positions in a squad on an offensive, defensive or special team, wherein each player has attributes which predict athletic performance (Madden, from pg 16 - 17);

a play code segment to establish a play based on a formation in which the moving pattern and activity of each player is defined (Madden, from pg 16 - 17); and

a run designed play code segment to simulate the play by having each player executing the moving pattern and activity as modified by the vital statistics, general attributes (Madden, pg 9, "The height and weight stats are customizable..."), offensive/defensive attributes (Madden, pg 16 - 17) and specialized attributes associated with each player (Madden, pg 9, "With the game's extensive general manager options, you can do everything from creating a player to creating an entire team...If you enjoy customizing your own team and players..."), wherein the outcome of the play is based upon the moving patterns and activities as modified by the attributes associated with each player (Madden, from pg 16).

Re claim 20:

The computer program for simulating an athletic event as recited in claim 19, further comprising:

a squad creation code segment to create a squad of players based upon the players entered using the player code segment (Madden, from pg 16, from pg 209), wherein each squad of players is associated with some specific game function, a formation code segment to establish for formation using the squad of players (Madden, from pg 16),

a playbook code segment to enter each play in a playbook categorized according to the type of play (Madden, from pg 209, "PLAYBOOKS"),

a player specific camera viewing code segment to view the play as either a two-dimensional overhead view, a two-dimensional side view, or three-dimensional animated player view, and (Madden, pg 2)

an exporting play code segment to export the play established in the form of a movie (Madden, pg 8 - 9).

Art Unit: 3715

Re claim 41:

A method for simulating an athletic event (Madden, pg 1 - 3), comprising:

entering players for positions in a squad on an offensive, defensive or special team, wherein each player has attributes which predict athletic performance (Madden, from pg 16);

placing each player in a formation (Madden, from pg 16);

establishing a play based on the formation in which the moving pattern and activity of at least one player is defined (Madden, from pg 16);

simulating the play by having the at least one player executing the moving pattern and activity as modified by the vital statistics, general attributes (Madden, pg 9, "The height and weight stats are customizable..."), offensive/defensive attributes (Madden, pg 16 - 17) and specialized attributes associated the at least one player (Madden, pg 9, "With the game's extensive general manager options, you can do everything from creating a player to creating an entire team...If you enjoy customizing your own team and players..."), wherein the outcome of the play is based upon the moving patterns and activities as modified by the attributes associated with the at least one player (Madden, from pg 16).

Re claim 42:

The method for simulating an athletic event recited in claim 51, wherein the vital statistics comprise the player's height and weight (Madden, pg 9), wherein the general attributes comprise acceleration (Madden, pg 16; pg 53 - 61), agility (Madden, pg 16; pg 53 - 61), awareness (Madden, pg 87 - 88; pg 106 - 107), elusiveness (Madden, pg 54 - 61; pg 97), jumping (Madden, pg 53 - 61), speed (Madden, pg 53 - 61), stamina (Madden, pg 91), and strength (Madden, pg 53 - 61), wherein the offensive/defensive attributes comprise breaking tackles (Madden, pg 16; pg 55 - 61), catching (Madden, pg 55 - 61), pass blocking (Madden, pg 90, pg 106), run blocking (Madden, pg 90, pg 106), throwing accuracy (Madden, pg 16; pg 58; pg 90), and throwing power (Madden, pg 16; pg 58; pg 90), wherein the specialized attributes comprise injury recovery (Madden, pg 33; "Once the season is over, the player will come off the IR (Injury Report) if the injury was not career-ending..."), toughness (Madden, pg 257), instinct and experience (Madden, pg 257).

Art Unit: 3715

Re claim 46:

A system for simulating an athletic event, comprising:

a player module to enter players for positions in a squad on an offensive, defensive or special team (Madden, from pg 16), wherein at least one player has vital statistics, general attributes (Madden, pg 9, "The height and weight stats are customizable..."), offensive/defensive attributes (Madden, pg 16 - 17) and specialized attributes (Madden, pg 9, "With the game's extensive general manager options, you can do everything from creating a player to creating an entire team...If you enjoy customizing your own team and players...") which predict athletic performance (Madden, from pg 16);

a play module to establish a play based on a formation in which the moving pattern and activity of the at least one player is defined; and (Madden, from pg 16; from pg 209)

a run designed play module to simulate the play by having the at least one player executing the moving pattern and activity as modified by the vital statistics, general attributes, offensive/defensive attributes and specialized attributes associated with the at least one player, wherein the outcome of the play is based upon the moving patterns and activities as modified by the vital statistics, general attributes, offensive/defensive attributes and specialized attributes associated with the at least one player (Madden from pg 16; from pg 209).

Re claim 47:

A computer program embodied on a computer readable medium for simulating an athletic event (Madden, from pg 16), comprising:

a player code segment to enter players for positions in a squad on an offensive, defensive or special team (Madden, from pg 16), wherein at least one player has vital statistics, general attributes (Madden, pg 9, "The height and weight stats are customizable..."), offensive/defensive attributes (Madden, pg 16 - 17) and specialized attributes (Madden, pg 9, "With the game's extensive general manager options, you can do everything from creating a player to creating an entire team...If you enjoy customizing your own team and players...") which predict athletic performance (Madden, from pg 16);

Art Unit: 3715

a play code segment to establish a play based on a formation in which the moving pattern and activity of the at least one player is defined; and (Madden, from pg 16; from pg 209)

a run designed play code segment to simulate the play by having the at least one player executing the moving pattern and activity as modified by the vital statistics, general attributes, offensive/defensive attributes and specialized attributes associated with the at least one player, wherein the outcome of the play is based upon the moving patterns and activities as modified by the vital statistics, general attributes, offensive/defensive attributes and specialized attributes associated with the at least one player (Madden, from pg 16; from pg 209).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 38 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madden NFL 2002 (Playstation 2 - release 8/19/2001) evident by www.gamespot.com (denoted herein after as Madden) in view of French et al. (US 6,308,565 B1).**

Re claim 38:

Madden discloses a method of simulating at least a portion of an athletic game or sport and for at least one player on a team participating in that game or sport, thereby facilitating the training of said one player under simulated game conditions and in the classroom rather than on the playing field or arena, and thereby substantially compressing the training time while avoiding a potential injury to said one player on the practice field or arena (Madden, pg 1 - 3); comprising the steps of,

first, presenting at least one of the team's defensive or offensive formations and intended subsequent play; and (Madden, from pg 16; from pg 209)

Art Unit: 3715

second, presenting the team's opponent's likely action or reaction in response thereto, respectively (Madden, from pg 16 - 29; Madden discloses a simulated football game that a player can learn about an opponent's strategy);

Madden does not disclose the first and second presentations are viewed from the position of said one player's own eyes had said one player been on the playing field or arena rather than from the perspective of a spectator. However, French teaches accurate simulation of sport to quantify and train performance. French further teaches a first person perspective which is a view on the display of the virtual space from the perspective of a player (French, col 31, lines 30 - col 32, line 21). Therefore, in view of French, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the method described in Madden, by providing the first person perspective as taught by French, since French explicitly states (French, col 32, lines 18 - 21) the display of a first person perspective increases the fidelity of the simulation, by making the view on the display closer to that which would be perceived by the player in a real life activity.

Re claim 39:

Madden discloses method further including the steps of

presenting all of the team's defensive or offensive formations and plays and the team opponent's likely actions or reactions in response thereto (Madden, from pg 16 - 29; Madden discloses a simulated football game that a player can learn about an opponent's strategy), and

customizing the presentations for each of the team's respective players on those formations and plays, further including the step of factoring in the capabilities for each of the team's respective players, thereby analyzing each of the team's formations and plays and determining which players on the team should be assigned to the respective formations and plays, and thereby tailoring the team to the opponent and tending to maximize the likelihood of the team beating its opponent (Madden, from pg 16; from pg 209).

Art Unit: 3715

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACK YIP whose telephone number is (571)270-5048. The examiner can normally be reached on Monday - Friday 9:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Y./
Examiner, Art Unit 3715
12/8/2008

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715